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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,912	03/15/2001	Atsushi Hanai	R2179.0000/P000	2913
24998	7590	12/17/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			THEIN, MARIA TERESA T	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	

3627

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/805,912

Applicant(s)

HANAI ET AL. 

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-19, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 20, 22 and 24-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-19, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-24-03; 7-10-03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group II, claims 13-19, 21 and 23 in the reply filed on November 8, 2004 is acknowledged. The traversal is on the ground(s) that the claims may be examined without "serious burden". This is not found persuasive because of their recognized divergent subject matter, different subclasses, or the search required for the, as set forth in the Office Action dated October 7, 2004.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-12, 20, 22, and 24-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 8, 2004.

Applicants are respectfully requested to cancel the non-elected claims in response to the Office Action.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on March 24, 2003 and July 10, 2003 are being considered by the examiner.

### ***Drawings***

The drawings filed on March 15, 2001 are acceptable.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For example claim 21, the preamble and the recited steps are not directed to anything in the technological arts. The recitation "defining relationship information for a plurality of items"; "storing client information....."; "specifying a client of an access source....."; "specifying a possessed item....."; and "determining, based on said relationship information....." have no structural or functional interrelationship with these method steps, which could all be performed manually by a person. Therefore, the claim is directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends the Applicant to amend the claims to better clarify which of the

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steps are being performed within the technological arts, such as –An item recommending method via computer network--.

Claim 23 is rejected under 35 U.S.C. 101 because it fails to recite computer executable instructions. The claims are directed to computer program product. The claims fail to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106. Furthermore, the phrase “outputting a signal” has no connection to the technological arts that enables a useful, concrete, tangible result. A signal per se is not the type of subject matter that is considered statutory. The “outputting a signal” is interpreted as an abstract arrangement that is transmitted or is a transmission in transit. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends the Applicant to amend the claims to better clarify what is being performed to the computer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 13, 15-19, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6, 266,649 to Linden et al.**

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Regarding claims 13, 21 and 23, Linden discloses an item recommending system, method and program (personalized recommendation of items, col. 2, lines 34-35) comprising: a client database which stores an item that a client possesses (user profile 38); a related information storing memory which contains relationship information concerning purchase items and related items (similar item table 40); a possessed item extractor which, in response to the client information, extracts from the client database the item the client possess (the items of known interest are selected from one or more of the following groups: (a) items in the user's purchase history, (b) items in the user's shopping cart, (c) items rated by the user, and (d) items in the recent shopping cart content, col. 10, lines 47-55); a related item extractor (the items of known interest are identified based on information stored in the user's profile, col. 10, lines 37-40); and a recommendation section (recommendation service component 44, Figure 1).

Regarding claims 15-19, Linden discloses a receiver which received identification information (user ID) (Figure 3); a specifier which specifies the client based on the received identification information (Figure 3); means for inputting item purchase information (users can add and remove items to/from a personal shopping cart; col. 4, lines 64-65; col. 7, lines 49-52); means for adding an item that the client possesses to the client database (processing modules for accepting and processing orders, and for updating the purchase histories of the users, col. 7, lines 45-48); wherein the related information storing memory stores a plurality of purchase items, an option item to be used as an option in each purchase item and/or a consumable item to be consumed in the purchase items, and the related information storing memory recommends the option

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item to the purchase item that the client possesses and/or the consumable item (col. 7, lines 20-33); a sales history (purchase histories for all customer); a memory which stores information on items show probability of simultaneous purchase is more than a reference value to the related information storing memory based on the sales history stored in the history storing memory (col. 2, line 61 – col. 3, line 6); and the sales history storing memory stores both the history of items sold together by a store and/or a salesperson and the history of items sold together via a network (col. 12, lines 5-9).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,266,649 to Linden et al. in view of U.S. Patent No. 6,064,982 to Puri.**

Linden substantially discloses the claimed invention, however, it does not disclose the discount information corresponding to a discount rate of a sales price. Linden discloses user profiles database which stores account-specific information about users (col. 7, lines 20-21). Puri, on the other hand, teaches the discount information corresponding to a discount rate of a sales price (a pricing calculation taking into account such factors or special pricing and discounts, col. 3, lines 59-61), so as to offer discount pricing breaks and other options to a customer (col. 5, lines 40-43).

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Linden, to include the discount information to a discount rate of a sales price, as taught by Puri, in order to offer discount pricing breaks and other option to a customer (Puri, col. 5, lines 40-43).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,909,023 to Ono et al. discloses an online shopping support system and method capable of supplying each use with merchandise information by utilizing a database of the purchase history of users.

U.S. Patent No. 6,041,311 to Chislenko discloses a method for recommending items to users using automated collaborative filtering stores profiles of users relating ratings to items in memory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot

December 10, 2004

*Michael Cuff* 12/13/04  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**